PTO Form 1930 (Rev 9/2007)
OMB No. 0651-0050 (Exp. 05/31/2014)

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	79119845
LAW OFFICE ASSIGNED	LAW OFFICE 115
MARK SECTION (no change)	
ARGUMENT(S)	
Please see the actual remarks attached in the evidence section.	
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_7089190201-130448352_._Remarks_to_Request_for_Reconsideration__for_filing__12-26-13.pdf
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ORIGINAL PDF FILE	evi_7089190201-130448352_._Exhibits__for_filing__12-26-13.pdf
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DESCRIPTION OF	

EVIDENCE FILE	remarks in response to the Office action and Exhibits referenced in the remarks
SIGNATURE SECTION	
RESPONSE SIGNATURE	/Mark Alleman/
SIGNATORY'S NAME	Mark D. Alleman
SIGNATORY'S POSITION	Attorney of Record, Oregon Bar Member
SIGNATORY'S PHONE NUMBER	503-459-4141
DATE SIGNED	12/26/2013
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Thu Dec 26 13:33:20 EST 2013
TEAS STAMP	USPTO/RFR-70.89.190.201-20131226133320990946-79119845-500c548c0a2a27bdb5c125c6772c3c7f4916e3709f13d8e566eb3212167c222ef-N/A-N/A-20131226130448352396

PTO Form 1930 (Rev 9/2007)
OMB No. 0651-0050 (Exp. 05/31/2014)

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **79119845** has been amended as follows:

ARGUMENT(S)
In response to the substantive refusal(s), please note the following:

Please see the actual remarks attached in the evidence section.

EVIDENCE
Evidence in the nature of remarks in response to the Office action and Exhibits referenced in the remarks has been attached.

Original PDF file:
evi_7089190201-130448352_._Remarks_to_Request_for_Reconsideration__for_filing__12-26-13.pdf
Converted PDF file(s) (7 pages)
Evidence-1
Evidence-2
Evidence-3
Evidence-4
Evidence-5
Evidence-6
Evidence-7
Original PDF file:
evi_7089190201-130448352_._Exhibits__for_filing__12-26-13.pdf
Converted PDF file(s) (3 pages)
Evidence-1
Evidence-2
Evidence-3

SIGNATURE(S)
Request for Reconsideration Signature
Signature: /Mark Alleman/ Date: 12/26/2013
Signatory's Name: Mark D. Alleman
Signatory's Position: Attorney of Record, Oregon Bar Member

Signatory's Phone Number: 503-459-4141

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 79119845
Internet Transmission Date: Thu Dec 26 13:33:20 EST 2013
TEAS Stamp: USPTO/RFR-70.89.190.201-2013122613332099
0946-79119845-500c548c0a2a27bdb5c125c677
2c3c7f4916e3709f13d8e566eb3212167c222ef-
N/A-N/A-20131226130448352396

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	Tateho Kagaku Kogyo Kabushiki Kaisha
Application No.	:	79/119,845
Filed	:	April 27, 2012
Mark	:	PUREMAG
International Classes	:	001
Examining Attorney	:	Marc J. Leipzig
Law Office	:	115
Docket No.	:	ACO13403MADUS
Date	:	December 26, 2013

Response to Office Action

This response is being submitted in reply to the Office Action mailed July 8, 2013. Applicant thanks the Examining Attorney for diligent examination of this application.

In the Office action mailed July 8, 2013, the Examining Attorney withdraws the refusal under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d) and TMEP §1207.01 *et seq.* and maintains a partial refusal under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1) and TMEP §§1209.01(b) and 1209.03 *et seq.* based on an assertion that the mark merely describes a portion of Applicant's goods, as follows: "magnesium hydroxide, magnesium oxide, magnesium carbonate; magnesium oxide ceramics in particle and compacted form used as target material for sputtering, electron-beam deposition, evacuated deposition." Applicant traverses the refusal under Sections 2(e)(1) of the Trademark Act as set forth below.

Section 2(e)(1) Refusal

Applicant respectfully disagrees with the Examining Attorney's assertion that Applicant's mark PUREMAG is merely descriptive of a portion of Applicant's goods, as follows: "magnesium hydroxide, magnesium oxide, magnesium carbonate; magnesium oxide ceramics in particle and compacted form used as target material for sputtering, electron-beam deposition, evacuated deposition." Applicant submits that the composite mark has no known meaning in relation to chemical compounds, and that the elements PURE and MAG are combined in such a way to render a composite which is at most suggestive of these goods. As the composite mark does not directly identify Applicant's chemical products or use or other characteristics, it cannot be said to immediately convey the nature of Applicant's goods.

For a mark to be merely descriptive, the mark must "immediately convey to one seeing or hearing it knowledge of the ingredients, qualities, or characteristics of the goods or services with which it is used." In *re MBNA America Bank, N.A., 340 F. 3d 1328, 1332, 67 U.S.P.Q.2d 1778 (Fed. Cir. 2003)* (quoting 2 McCarthy, Trademarks and Unfair Competition, §11:19 at p. 11-38 (4d ed. 2013)). In contrast to descriptive marks, suggestive marks "are defined as those which require the exercise of thought, imagination or perception to determine a mark's meaning in relation to the goods." *Economics Lab., Inc. v. Scott's Liquid Gold, Inc.*, 224 USPQ 512, 515 (TTAB 1984).

Factors to be considered in determining whether a mark is suggestive or merely descriptive include the following:

> (1) the level of imagination, thought or perception required to reach a conclusion as to the nature of the goods;…(2) the likelihood that

> competitors will need to use the term in connection with their goods;…(3) the extent to which other sellers have used the mark on similar merchandise – frequent use will indicate descriptiveness;…(4) the likelihood that the mark will conjure up other purely arbitrary connotations separate from what the mark conveys about the product;…[and] (5) probability consumers will regard the mark as a symbol of origin or as self-laudatory.

FM 103.1m Inc. v. Universal Board, 929 F. Supp. 187 (D.N.J. 1996).

(1) the level of imagination, thought or perception required to reach a conclusion as to the nature of the goods, and (4) the likelihood that the mark will conjure up other purely arbitrary connotations separate from what the mark conveys about the product

As noted in *J & J Snack Foods, Corp. v, Nestle USA, Inc.*, 149 F. Supp. 2d 136 (2001), "points (1) and (4) can be considered together because of the level of imagination required to 'get' the mark is naturally related to whatever arbitrary connotations an imaginative mark might create."

The issue is whether the composite mark, and not its individual elements, merely describes features or characteristics of the goods. In this case, the composite mark PUREMAG is not a known abbreviation for or term meaning magnesium hydroxide, magnesium oxide, magnesium carbonate, or magnesium oxide ceramics, which are the magnesium-containing compounds provided by Applicant. As Applicant's composite mark PUREMAG is not a known abbreviation for the chemical compounds listed above, it can be said that Applicant's composite mark does not immediately convey the nature of Applicant's goods. Thus, Applicant submits that its composite mark is sufficiently distinctive to support registration. See *Nife Incorporated v. Gould-National Batteries,*

Inc., 128 U.S.P.Q. 453, 1961 WL, 8056 (T.T.A.B. 1961) (wherein the Board found NICAD, for use with nickel cadmium, sufficiently arbitrary, deciding that the mark did not constitute a recognized abbreviation of "nickel cadmium").

The Examining Attorney provides evidence asserted to demonstrate that MAG is a known abbreviation for magnesium or magnesium-containing products. However, Applicant respectfully submits that this evidence only establishes that MAG is a known abbreviation for magnesium (as well as for a litany of other terms, including metal active gas, magnetometer, magazine, etc.), but not as an abbreviation for magnesium-containing compounds in general. As such, Applicant submits that, because MAG does not immediately invoke magnesium or magnesium-containing products, it cannot be said that Applicant's composite mark is descriptive of Applicant's goods.

Further, Applicant refers to the evidence of record, which demonstrates that MAG is a known abbreviation for myriad terms, including (but not limited to) metal active gas, magnetometer, and magazine. Due to the numerous words for which MAG is an abbreviation, it is likely that the mark will conjure up other purely arbitrary connotations separate from what the mark might convey about Applicant's goods. Thus, Applicant submits that its composite mark is sufficiently distinctive to support registration. Nevertheless, even if MAG is construed as descriptive of Applicant's specific goods, Applicant notes that telescoping descriptive terms – combining two descriptive words to create a standalone composite – can result in a non-descriptive composite mark sufficiently distinctive to support registration. See *Aluminum Fabricating Co. v. Season-All Window Corp.*, 259 F.2d 314, 119 U.S.P.Q. 61 (2d Cir. 1958) (the Board found that,

although a mere reversal of the mark SEASON-ALL ("All Season") was admittedly descriptive, the mark was ultimately granted registration due to the "unusual order" of the wording which added a quality of arbitrariness enough to justify registration); *Firestone Tire & Rubber Co. v. Goodyear Tire & Rubber Co.*, 186 U.S.P.Q. 557 (T.T.A.B. 1975) aff'd, 189 U.S.P.Q. 348 (C.C.P.A. 1976) (in considering the case of BIASTEEL for use with steel belted bias tires, the Board found that the mark was merely suggestive, and not descriptive, as a standalone mark); see also *Nife Incorporated v. Gould-National Batteries, Inc.*, 128 U.S.P.Q. 453, 1961 WL, 8056 (T.T.A.B. 1961).

Applicant submits that, due to the level of imagination required to reach a conclusion as to the nature of Applicant's goods, in addition to the probability that the mark will conjure up other purely arbitrary connotations separate from what the mark conveys about the product, Applicant's mark is sufficiently distinctive as to support registration.

(2) the likelihood that competitors will need to use the term in connection with their goods; (3) the extent to which other sellers have used the mark on similar merchandise – frequent use will indicate descriptiveness

Applicant respectfully submits that, to the best of Applicant's knowledge, PUREMAG has no known significance specific to Applicant's industry or products or any well-known meaning in any other context. Applicant acknowledges the evidence of record defining "pure" as "free from extraneous matter" or "not mixed with anything else," and notes that to the best of Applicant's knowledge the term has no special

meaning specific to Applicant's industry or products other than its ordinary definition. Within Applicant's industry, it is common practice to indicate the extent to which a substance is free of extraneous matter. As purity in this context is a matter of degree, the binary categories "pure" and "impure" are uninformative. Rather, those in the trade use terms such as "high-purity" to express a high degree of freedom from extraneous materials or tiered designators such as "3N", "4N", and "5N" to express purity grades. Examples are shown in Exhibit A, a printout of a website related to magnesium oxide pellets. As such, Applicant submits that it is unlikely that competitors will need to use the term "PUREMAG" in relation to their goods, nor does there appear to be frequent use of "PUREMAG" by third-parties within the relevant industry.

In light of the evidence that, within Applicant's industry, it is common practice to use wording such as "pure" to indicate the *degree* to which a substance is free of extraneous matter and not necessarily the exact nature of its purity, Applicant's applied-for mark PUREMAG does not immediately convey any feature of Applicant's goods, but instead is merely suggestive of the partially refused goods. Further, the evidence of record also demonstrates that there is infrequent use of "PUREMAG" by third-parties within the relevant industry and, as a result, it can be surmised that it is unlikely that competitors will need to use the term "PUREMAG" in relation to their goods.

Conclusion

Applicant believes the application is now in condition for publication, and requests that the application be approved for registration. Should any issues remain that may be

resolved by telephone call, the Examining Attorney is encouraged to telephone the undersigned.

Respectfully Submitted,

Mark D. Alleman

Alleman Hall McCoy Russell & Tuttle LLP

EXHIBIT A

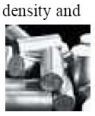
Magnesium Oxide Pellets

MgO
CAS 1309-48-4

Product	Product Code	Order or Specifications
(2N) 99% Magnesium Oxide Pellets	MG-OX-02-PE	Contact
(3N) 99.9% Magnesium Oxide Pellets	MG-OX-03-PE	Contact
(4N) 99.99% Magnesium Oxide Pellets	MG-OX-04-PE	Contact
(5N) 99.999% Magnesium Oxide Pellets	MG-OX-05-PE	Contact

	Formula	CAS No.	PubChem SID	PubChem CID	MDL No.	EC No	IUPAC Name	Beilstein Re. No.	SMILES Identifier	InChI Identifier	InChI Key
CHEMICAL IDENTIFIER	MgO	1309-48-4	24877703	14792	MFCD00011109	215-171-9	oxomagnesium	N/A	[Mg+2].[O-2]	InChI=1S/Mg.O/q+2;-2	AXZKOIWUVFPNLO-UHFFFAOYSA-N

	Compound Formula	Mol. Wt.	Appearance	Melting Point	Boiling Point	Density	Exact Mass	Monoisotopic Mass	Charge	MSDS
PROPERTIES	MgO	40.30	White Powder	2,852° C (5,166° F)	3,600° C (6,512° F)	3.58 g/cm^3	39.98	39.98	0	Safety Data Sheet



American Elements specializes in producing high purity uniform shaped Magnesium Oxide Pellets with the highest possible density and smallest possible average grain sizes for use in semiconductor, Chemical Vapor Deposition (CVD) and Physical Vapor Deposition (PVD) processes including Thermal and Electron Beam (E-Beam) Evaporation, Low Temperature Organic Evaporation, Atomic Layer Deposition (ALD), Metallic-Organic and Chemical Vapor Deposition (MOCVD). Our standard Pellet sizes range from 1/8" x 1/8" to 1/4" x 1/4" and 3 mm diameter. We can also provide Pellets outside this range for ultra high purity thin film applications, such as fuel cells and solar energy layers. Materials are produced using crystallization, solid state and other ultra high purification processes such as sublimation. American Elements specializes in producing custom compositions for commercial and research applications and for new proprietary technologies. American Elements also casts any of the rare earth metals and most other advanced materials into rod, bar or plate form, as well as other machined shapes and through other processes such as nanoparticles (See also application discussion at Nanotechnology Information and at Quantum Dots) and in the form of solutions and organometallics. We also produce Magnesium Oxide as pieces, tablets, powder, and sputtering target. Oxide compounds are not conductive to electricity. However, certain perovskite structured oxides are electronically conductive finding application in the cathode of solid oxide fuel cells and oxygen generation systems. See research below. Other shapes are available by request.

Magnesium is a Block S, Group 2, Period 3 element. The number of electrons in each of Magnesium's shells is 2, 8, 2 and its electronic configuration is [Ne] $3s^2$. In its elemental form magnesium's CAS number is 7439-95-4. The magnesium atom has a radius of 159.9.pm and its Van der Waals radius is 173.pm. Magnesium is the eighth most abundant element in the earth's crust. It is one-third lighter than aluminum, and because of this is used in alloys that are essential for aerospace, satellite and missile construction. The metal improves the mechanical, fabrication, and welding characteristics of aluminum when used as an alloying agent. Uses also include flares and pyrotechnics due to its pyrophoric properties. Magnesium compounds, primarily magnesium oxide, are used mainly as refractory material in furnace linings for producing iron and steel, nonferrous metals, glass, and cement; the global industrial demand for Magnesium Oxide Nanopowder in particular is predicted to grow by 8.7% from 2013 to 2018, according to a December 2012 report from Transparency Market Research. High purity magnesium is found in dietary supplements. Magnesium is commercially produced from brucite, carnallite, dolomite, magnesite, olivine and talc. Magnesium was first discovered by Sir Humphrey Davy in 1808. The name Magnesium originates from a Greek district in Thessaly called Magnesia. See Magnesium research below.


Elemental Magnesium


Magnesium (Mg) Bohr Model

HEALTH, SAFETY & TRANSPORTATION INFORMATION

Material Safety Data Sheet	MSDS
Signal Word	N/A
Hazard Statements	N/A
Hazard Codes	N/A
Risk Codes	N/A
Safety Precautions	N/A
RTECS Number	OM3850000
Transport Information	N/A
WGK Germany	1
Globally Harmonized System of Classification and Labelling (GHS)	N/A

MANGNESIUM OXIDE SYNONYMS

Magnesia, Periclase, Oxymagnesium, Light magnesia, Marmag, Causmag, Granmag, Maglite, Magox, BayMag, Calcined magnesia, Seasorb, Animag, Magcal, Heavy magnesia, Calcined brucite, Ketomagnesium

CUSTOMERS FOR MAGNESIUM OXIDE PELLETS HAVE ALSO LOOKED AT

Magnesium Sputtering Target Magnesium Acetate Magnesium Oxide Magnesium Nanoparticles Magnesium Powder

Magnesium Metal | Magnesium Chloride | Magnesium Iodide | Magnesium Wire | Magnesium Oxide Pellets
Magnesium Nitrate | Magnesium Selenide | Magnesium Foil | Magnesium Acetylacetonate | Magnesium Pellets

EXHIBIT A

Show Me MORE Forms of Magnesium

PACKAGING SPECIFICATIONS FOR BULK & RESEARCH QUANTITIES

Typical bulk packaging includes palletized plastic 5 gallon/25 kg. pails, fiber and steel drums to 1 ton super sacks in full container (FCL) or truck load (T/L) quantities. Research and sample quantities and hygroscopic, oxidizing or other air sensitive materials may be packaged under argon or vacuum. Shipping documentation includes a Certificate of Analysis and Material Safety Data Sheet (MSDS). Solutions are packaged in polypropylene, plastic or glass jars up to palletized 440 gallon liquid totes.

Recent Research & Development for Magnesium

- Influence of the grain size on the in vivo degradation behaviour of the magnesium alloy LAE442. Ullmann B, Reifenrath J, Seitz JM, Bormann D, Meyer-Lindenberg A. Proc Inst Mech Eng H. 2013 Mar;227(3):317-26.
- Impact of Methimazole Treatment on Magnesium Concentration and Lymphocytes Activation in Adolescents with Graves' Disease. Klatka M, Grywalska E, Partyka M, Charytanowicz M, Rolinski J. Biol Trace Elem Res. 2013 May 11. [Epub ahead of print]
- Uniform magnesium silicate hollow spheres as high drug-loading nanocarriers for cancer therapy with low systemic toxicity. Wang B, Meng W, Bi M, Ni Y, Cai Q, Wang J. Dalton Trans. 2013 May 9. [Epub ahead of print]
- Elevation of brain magnesium prevents and reverses cognitive deficits and synaptic loss in Alzheimer's disease mouse model. Li W, Yu J, Liu Y, Huang X, Abumaria N, Zhu Y, Huang X, Xiong W, Ren C, Liu XG, Chui D, Liu G. J Neurosci. 2013 May 8;33(19):8423-41. doi: 10.1523/JNEUROSCI.4610-12.2013.
- Well-Defined Molecular Magnesium Hydride Clusters: Relationship between Size and Hydrogen-Elimination Temperature. Intemann J, Spielmann J, Sirsch P, Harder S. Chemistry. 2013 May 9. doi: 10.1002/chem.201300684. [Epub ahead of print]
- Hydrochlorothiazide and high-fat diets reduce plasma magnesium levels and increase hepatic oxidative stress in rats. Ribeiro MC, Avila DS, Barbosa NB, Meinerz DF, Waczuk EP, Hassan W, Rocha JB. Magnes Res. 2013 May 6. [Epub ahead of print]
- The design of ultrasonic lead magnesium niobate-lead titanate composite transducers for power and signal delivery to implanted hearing aids. Leadbetter J, Brown J, Adamson R. J Acoust Soc Am. 2013 May;133(5):3268. doi: 10.1121/1.4805305.
- [Influence of magnesium supplementation on insulin receptor affinity in erythrocytes of type 2 diabetes rats]. Zhong W, Fang F, Cheng X, Li C. Wei Sheng Yan Jiu. 2013 Mar;42(2):217-20. Chinese.
- Evidence for Cross-Tolerance to Nutrient Deficiency in Three Disjunct Populations of Arabidopsis lyrata ssp. lyrata in Response to Substrate Calcium to Magnesium Ratio. Veatch-Blohm ME, Roche BM, Campbell M. PLoS One. 2013 May 1;8(5):e63117. doi: 10.1371/journal.pone.0063117. Print 2013.
- Magnesium Chloride Concentration-Dependent Formation of Tofu-Like Precipitates with Different Physicochemical Properties. Arii Y, Takenaka Y. Biosci Biotechnol Biochem. 2013 May 7. [Epub ahead of print]
- The simultaneous removal of calcium, magnesium and chloride ions from industrial wastewater using magnesium-aluminum oxide. Hamidi R, Kahforoushan D, Fatehifar E. J Environ Sci Health A Tox Hazard Subst Environ Eng. 2013;48(10):1225-30. doi: 10.1080/10934529.2013.776855.
- Magnesium-Tartramide Complex Mediated Asymmetric Strecker-Type Reaction of Nitrones Using Cyanohydrin. Sakai T, Soeta T, Endo K, Fujinami S, Ukaji Y. Org Lett. 2013 May 6. [Epub ahead of print]
- The effect of intravenous magnesium sulfate on serum levels of N-terminal pro-brain natriuretic peptide (NT pro-BNP) in elective CABG with cardiopulmonary bypass. Dabbagh A, Bastanifar E, Foroughi M, Rajaei S, Keramatinia AA. J Anesth. 2013 May 4. [Epub ahead of print]
- Seawater-driven magnesium based Janus micromotors for environmental remediation. Gao W, Feng X, Pei A, Gu Y, Li J, Wang J. Nanoscale. 2013 May 2. [Epub ahead of print]
- Magnesium Lithospermate B Protects Neurons from N-Methyl-D-Aspartic Acid Injury and Attenuates Kainic Acid-Induced Neurodegeration in FVB Mice. Xiao G, Hu W, Chen X. J Mol Neurosci. 2013 May 3. [Epub ahead of print]
- Magnesium ? its role in CKD. M de Francisco AL, Rodríguez M. Nefrologia. 2013 May 2. doi: 10.3265/Nefrologia.pre2013.Feb.11840. [Epub ahead of print] English, Spanish.
- Magnesium phosphate cements for endodontic applications with improved long-term sealing ability. Mestres G, Aguilera FS, Manzanares N, Sauro S, Osorio R, Toledano M, Ginebra MP. Int Endod J. 2013 Apr 9. doi: 10.1111/iej.12123. [Epub ahead of print]
- Effects of magnesium sulphate on the pharmacodynamics of rocuronium in patients aged 60 years and older: A randomised controlled study. Rotava P, Cavalcanti IL, Barrucand L, Vane LA, Verçosa N. Eur J Anaesthesiol. 2013 Apr 30. [Epub ahead of print]
- Effect of maternal body mass index on serum magnesium levels given for seizure prophylaxis. Baxi LV. Obstet Gynecol. 2013 May;121(5):1110. doi: 10.1097/AOG.0b013e31828fc3d1. No abstract available.
- Tetra-aqua-bis-(3,5-dinitro-benzoato-?O (1))magnesium tetra-hydrate. Smith G. Acta Crystallogr Sect E Struct Rep Online. 2013 Mar 16;69(Pt 4):m215. doi: 10.1107/S160053681300682X. Print 2013 Apr 1.

EXHIBIT A